

## REMARKS

Applicants acknowledge and appreciate the indication that claims 1-9 are allowed. Claims 10 and 11 have now been rejected as being obvious in view of Brunson and Pause. Applicants respectfully traverse.

The sole articulated motivation for combining Brunson and Pause is that to do so would "increase the adjustability of the handle in the Brunson's saw". (Office Action, p. 2, para. 4). There is, however, no identification provided as to where this motivation is derived.

As the Federal Circuit recently reiterated, mere identification in the prior art of each element is insufficient to defeat the patentability of the combined subject matter as a whole. *In re Kahn*, \_\_\_ USPQ2d \_\_\_, (Fed. Cir. March 22, 2006) (attached at Tab 1). Rather, the basis on which it is concluded that it would have been obvious to make the claimed invention must be articulated. In practice, this requires an explanation why one of ordinary skill in the art would have been motivated to select the references and to combine them. Without any explanation, there is an inference that the hindsight was used. Here, there is only the simple conclusion that modifying Brunson would increase the adjustability of the handle. While that may be true, it does not explain, as the Federal Circuit requires, why one skilled in the art would have been motivated to make such a modification.

There is nothing in Brunson that suggests that such a modification should have been made, would have been desirable, or would have solved any particular problem. Pause arrived at his invention in order to solve the problem when "an angular cut is to be made in a position that is not easily accessible ... the handle [can be moved] in the

desired angular position". (lines 70-86). The problem facing Pause is not one that the user of the Brunson device would face. Thus, Pause does not provide any motivation to one of ordinary skill in the art to modify Brunson. Without any motivation, the proposed combination does not establish a *prima facie* case of obviousness and the rejection should be withdrawn.

If, for any reason, the Examiner feels that the above amendments and remarks do not put the claims in condition for allowance, the undersigned attorney can be reached at (312) 321-4276 to resolve any remaining issues.

Respectfully submitted,



G. Peter Nichols  
Registration No. 34,401

BRINKS HOFER GILSON & LIONE  
P.O. BOX 10395  
CHICAGO, ILLINOIS 60610  
(312) 321-4200